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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,260

07/24/2003

Robert Greenberg

S202-USA

7590

28284 7590 08/17/2007
SECOND SIGHT MEDICAL PRODUCTS, INC.
12744 SAN FERNANDO ROAD
BUILDING 3
SYLMAR, CA 91342

EXAMINER

GETTMAN, CHRISTINA DANIELLE

ART UNIT

PAPER NUMBER

3734

MAIL DATE

DELIVERY MODE

08/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/627,260

Applicant(s)

GREENBERG ET AL.

Examiner

Christina D. Gettman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 07/24/2003, 04/12/2007.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5, 8, 11, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hughes (U.S. Patent No. 5,962,027). Hughes discloses the invention as claimed including a surgical tool for insertion of a retinal implant including an end portion with a rounded point (ref. 34), a base portion (ref. 32b), a top portion (ref. 32a), a space between the base portion and top portion (ref. 32c and 32d provide a space between the top and bottom portions), the base portion being parallel to the top portion (see Fig. 11), the top portion and base portion being curved to radii that approximates the radius of an eye (see Fig. 10 and 12), and the tool being made from a biocompatible elastic material (col. 8, lines 8-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10, as applied to claim 8 above, and 12-15, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes in view of Chow (EP

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0460320 A1). Hughes discloses the invention substantially as claimed including a method (see Fig. 19-20; col. 8, line 60-col. 9, line 65) of introducing an implant including providing a tool with the above listed features, placing the implant between the top and bottom portion of the tool, passing the tool and implant into a body, using the rounded point to separate extra ocular muscle, inserting the tool into an orbital socket, and releasing the implant from the tool. Hughes does not disclose the implant being an electrode. Chow teaches an electrode array being inserted into the retina (ref. 10 and ref. 78) for the purpose of stimulating the eye. It is also common for electrode arrays to have a cable coming off of them to be attached to other parts of the eye. Therefore, it would have been obvious to have modified the implant of Hughes to be an electrode in order to promote stimulation of the eye to increase eye sight. Hughes does not disclose using either ABS or stainless steel. ABS and stainless steel are commonly used medical materials and it would, therefore, be obvious to have made the device of Hughes out of ABS or stainless steel in order to be used in the body. Hughes also does not disclose inserting the tool into the orbital socket through a hole in the skull. However, this step of inserting a retinal implant is common practice. Therefore, it would have been obvious to have modified Hughes with inserting the tool through the skull in order to prevent unnecessary damage to the eye.

Claims 2, 6, 7, 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes as applied to claim 1 above, and further in view of Tarrson et al. (U.S. Patent No. 4,925,073). Hughes discloses the invention substantially as claimed except for a hinge connecting the top and base portion, a keeper connected to the base

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portion, notches in the base, or applying pressure to the two portion to retain the electrode array. Tarrson et al. teach a holder with a base portion and top portion that are connected by a hinge for the purpose of opening and closing the tool, a keeper (ref. 86 and 88; keep the two portion from moving away from one another unless the keeper is moved) connected to the base portion for the purpose of preventing movement of the top portion, a notch in the base for the purpose of mating with a guide on the top portion (ref. 86 and 88; act as a notch and guide), and applying pressure to the two portion for the purpose of holding the electrode array (the container holds the inner piece inside by having the side walls apply pressure on the inner piece). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Hughes with a holder with a base portion and top portion that are connected by a hinge in order to allow the tool to open to insert an implant and close to hold the implant, a keeper connected to the base portion in order to prevent the top portion from moving away from the bottom portion, a notch in the base in order to allow the top and base portion to align with one another and stay closed, and applying pressure to the two portion in order to prevent the implant from being prematurely released from the tool.

Double Patenting

Claims 1-20 of this application conflict with claims 1-20 of Application No. 11/440541. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either

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cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 11/440541. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christina D. Gettman whose telephone number is 571-272-3128. The examiner can normally be reached on Monday-Friday 7:15 am to 3:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on 571-272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Christina Gettman
Art Unit 3734
571-272-3128



MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER